

REMARKS

In the Office Action, the Examiner noted that claims 1-45 are pending in the application, and that claims 1-45 are rejected. By this amendment, claims 1, 37, 38 and 43-45 have been amended, and claim 46 has been added. Thus, claims 1-46 are pending in the application. The Examiner's rejections are traversed below.

Objection to the Claims

Claims 1-45 are objected to as containing informalities. Applicant thanks the Examiner for the detailed review of the claims. Applicant has amended the claims to remove the noted informalities. Accordingly, Applicant respectfully submits that the claims are in appropriate format. Withdrawal for his rejection is respectfully requested.

Rejection of the Claims Under 35 U.S.C. Section 112, Second Paragraph

Claims 1-45 stand rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim, the subject matter that applicant regards as the invention. Applicant respectfully traverses this rejection.

The Examiner states in the rejection that the terms "immediate certainties," "near certainties," and "long-term possibilities" are relative terms that render the claims indefinite. Applicant respectfully disagrees. These terms are clearly defined in the Summary of The Invention in the patent application, which states that:

"The agent is tactical because it considers not only immediate certainties and near certainties (e.g., if a hostile fighter is not shot at it will shoot at us) but also longer-term possibilities (e.g., if the bulk of our fighters are committed early, they may not be available should an enemy strike force appear in the future)."

Applicant respectfully submits that there is nothing relative in the above definition that would render the claims indefinite. Relative terms may be used in patent claims without rendering the claims indefinite. For example, the Board of Patent Appeals and Interferences Federal Circuit has held:

Accordingly, we consider the recitation of "substantial pressure contact" of claim 19 to be supported by the original disclosure; the word substantial being construed as a relative term denoting a desired degree of pressure contact for effecting the gravure printing function.

Ex parte George, 230 USPQ 575, 577 (B.P.A.I. 1984). In addition, the Court of Customs and Patent Appeals (CCPA) has held the following:

It is realized that "substantial distance" is a relative and somewhat indefinite term, or phrase, but terms and phrases of this character are not uncommon in patents in cases where, according to the art involved, the meaning can be determined with reasonable clearness.

In re Hutchison, 42 USPQ 90, 93 (C.C.P.A. 1939). In addition, the Federal Circuit has also approved the use of relative terms:

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. § 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988) the court explained that usages such as "substantially equal" and "closely approximate" may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that "like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995).

It is well established that when the term "substantially" serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite.

Verve LLC v. Crane Cams Inc., 311 F.3d 1116, 65 USPQ 2d 1051, 1054 (Fed. Cir. 2002)

Applicant further submits that it is well known by the software and the people who use it when hostile fire is imminent. It is also well understood what it means not to overcommit fighters early. The definitions are definite and present no difficulty to those skilled in the art.

The Manual of Patent Examining Procedure (MPEP) clearly permits claims to be drafted in the format of the currently pending claims. For example, the MPEP states at § 2173.02 (8th ed. Rev. 1, Feb. 2003):

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

Similarly, the MPEP states at § 2173.02 (8th ed. Rev. 1, Feb. 2003).

The test for definiteness under 35 U.S.C. 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). . . . If applicant does not accept the examiner's suggestion, the examiner should not pursue the issue.

The Applicant and Inventor would also like to point out that the very essence of tactics is precisely as defined, and the tactical (and intelligent) software agent is used for this very purpose. Scores of Department of Defense personnel have used the claimed agents and have

found them to be very much tactical as well as helpful in tactical situations. In fact, according to the Inventor, being able to react, for example, to certain facts and to delay decisions is an example of why the agent is tactical and why the definitions are precise and not relative.

With respect to the Examiner's rejection of the claims as not being definite for not reciting a positive step, Applicant respectfully traverses this rejection. Specifically, with respect to the Examiner's statements that claims 1 and 43-45 do not "delimit" how the steps are to be performed and the omission of "data and specifications," Applicant respectfully submits that this is an inappropriate application of the definiteness requirement under 35 U.S.C. §112, second paragraph. Applicant objects to the Examiner's attempt to force the applicant to rewrite the claims to include additional requirements/limitations. Applicant should be free to write their claims in any manner as they see fit. As stated by the Court of Customs and Patent Appeals:

By statute, 35 U.S.C. 112, Congress has placed no limitations on how an applicant claims his invention, so long as the specification concludes with claims which particularly point out and distinctly claim that invention.

In re Pilkington, 162 USPQ 145, 148 (C.C.P.A. 1969) (quoting *In re Steppan*, 156 USPQ 143, 148 (C.C.P.A. 1968)). Similarly, the Board of Patent Appeals and Interferences has stated:

In our judgment, a patent applicant is entitled to a reasonable degree of latitude in complying with the second paragraph of 35 U.S.C. § 112 and the examiner may not dictate the literal terms of the claims . . . Stated another way, a patent applicant must comply with 35 U.S.C. § 112, second paragraph, but just how the applicant does so, within reason, is within applicant's discretion.

In re Tanksley, 37 USPQ 2d 1382, 1386 (B.P.A.I. 1994).

The Board has also stated that, "It is well established that the invention claimed need not be described *ipsis verbis* in order to satisfy the disclosure requirement of §112." *Ex parte Holt*, 19 USPQ 2d 1211, 1213 (B.P.A.I. 1991). The CCPA has stated the following:

The absence of the limitation has a precise meaning. . . . This principle is the very basis of this court's consistent refusal to read limitations of the specification into the claims. . . . In our recent decision in *In re Wakefield*, . . . we considered an indefiniteness rejection involving the absence of a limitation. We reversed the rejection, stating . . . : "The scope of the claim is still definite, however, because each recited limitation is definite."

In re Fisher, 166 USPQ 18, 23 (C.C.P.A. 1970). Accordingly, Applicant respectfully submits that the presently claimed invention is definite. Withdrawal of this rejection is respectfully submitted.

In addition, the Applicant/Inventor strongly disagrees with the Examiner's statement that steps are omitted in configuring a tactical agent and implementing the decision making processes. The functional description of the agent is provided with explicit discussion of both state (data) and operations on the state. According to the Applicant/Inventor, this constitutes ample specification, whether in the claims or in the specification. Similarly, the decision-making processes are amply described, both verbally and in the Figures.

At 21st Century Systems, Inc., the Assignee of the present application and for whom the Inventor is the founder, novice, straight out of school programmers, that are interviewed are provided with test questions, including a partial specification of the very same kind in the present application. Candidates are then asked to extend the specification, first at specification level and then with concrete code (in Java or C/C++). Most novice programmers have no difficulty whatsoever providing correct answers and none to date have misinterpreted the provided part.

Accordingly, Applicant respectfully submits that claims 1-45 satisfy the requirements under 35 U.S.C. Section 112, second paragraph. Withdrawal of this rejection is respectfully requested.

Rejection of the Claims Under 35 U.S.C. Section 101

Claims 1-45 stand rejected under 35 U.S.C. Section 101 as being directed to non-statutory subject matter. Applicant respectfully traverses this rejection.

The Examiner objects to the claimed recitation of “configuring data, processing a combat situation and implementing a decision.” The Examiner states that the “claims fail to provide the steps necessary **to enable** the claimed process.” Applicant disagrees that this is a requirement under 35 U.S.C. Section 101. Specifically, claim need not enable the invention. As stated by the Federal Circuit:

A claim need not claim every function of a working device. Rather, a claim may specify improvements in one function without claiming the entire machine with its many functions.

Rodime PLC v. Seagate Tech., Inc., 50 USPQ 2d 1429, 1435 (Fed. Cir. 1999). In addition, the CCPA has held:

Moreover, it is not the normal function of a claim to disclose the invention, but to point out the features of novelty in the invention as disclosed in the specification and drawing of the application.

Bocciarelli v. Huffman, 109 USPQ 385, 388 (C.C.P.A. 1956).

Applicant would like to emphasize that the Examiner should not attempt to force the Applicant to redraft claims. As stated by the CCPA: “An applicant is entitled to claims as broad

as the prior art and his disclosure will allow.” *In re Rasmussen*, 211 USPQ 323, 326 (C.C.P.A. 1981).

With respect to the Examiner’s statement that the claims are not limited to practical applications, Applicant respectfully disagrees. All claims recite a “method of decision making in at least one combat situation.” All claims recite the use of a computer in implementing and/or assisting in the method. Applicant does not agree that the use of the invention in combat situations is not within the technological arts. Further, the present invention is actually in use on at least one aircraft carrier. Accordingly, the U.S. Navy clearly believes that the invention has utility. Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the

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Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

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AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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